

REMARKS

1. Applicant thanks the Examiner for his helpful comments and suggestions.
2. It should be appreciated that Applicant has elected to amend Claims 1, 11, 29, and 30 solely for the purpose of expediting the patent process in a manner consistent with the PTO's Patent Business Goals, 65 Fed. Reg. 54603 (9/8/00). In making such amendments, Applicant has not and does not in any way narrow the scope of protection to which the Applicant considers the invention herein entitled. Rather, Applicant reserves Applicant's right to pursue such protection at a later point in time and merely seeks to pursue protection for the subject matter presented in this submission.

Hilton-Davis / Festo Statement

As to Claims 1, 11, 29, and 30, amendments herein were not made for any reason related to patentability. As to Claims 1, 11, 29, and 30, amendments were made to use language supported by the application. Claim 1 was further amended to add an additional causal limitation. Amendments to Claims 1, 11, and 29 clarified language. Further amendments to Claims 1 and 11 were made to conform with standard claim drafting practices. None of the foregoing amendments were related to the pending rejections; all amendments were made for reasons other than patentability.

3. The amendment filed on March 17, 2005 stands objected to under 35 U.S.C. § 132(a) because it introduced new matter into the disclosure.

By way of amendment to the specification, the Applicant cancels all subject matter introduced into the application at page 5, lines 17-26 in the amendment filed March 17, 2005.

4. Claims 1, 11, 29, and 30 stand rejected under 35 U.S.C. § 112 first paragraph as failing to comply with the enablement requirement

Applicant amends Claims 1, 11, and 29, to clarify the case of when an the instant messaging service is not communicatively coupled to both a microphone and a speaker at the user's side that a verbal-textual communication between the caller and the user is established by enabling speech-to-text and/or text-to-speech software conversion. Applicant amends Claim 30 to clarify that software is used for text-to-speech and speech-to-text conversion. Support for the amendments is found in multiple sections of the application as filed. The application as filed at page 5, lines 20-21 teaches that text-to-speech and/or speech-to-text software may be employed. Further support for the amendments is found in the application as filed at least at page 6, lines 4-5. The specification also provides support at page 11, lines 3-6 describing that the subscriber's device may be configured to employ text/speech conversion and at page 11, lines 22-24 that speech-to-text conversion may be applied to provide the message to the subscriber. Still further, support is found in the specification at page 13, lines 14-15 teaching that text/speech conversion software may be executed as necessary.

5. Claims 1-3, 5-9, 11-24, and 26-33 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. patent no. 6,404,860 (hereinafter Casellini).

#### **Claims 1 and 29**

As to Claims 1 and 29, the Applicant respectfully disagrees. The Examiner cites Casellini at column 4, lines 14-41 as teaching the instant messaging service as offering one or more options based upon a profile of the user. In the cited section, Casellini teaches determining where the user is currently accessible via the internet and sending a notification to the user. The Examiner states that the

"user has established the call manager profile." There are at least two problems with this conclusion.

First, the cited section of Casellini does not state anything about the user having established the call manager profile. There exist a number of methods by which a call manager may be established. For example, the call manager may be a default of program installation having no user configuration. As the call manager may be using default options, it may not be logically induced that Casellini meant for the reader to read into his words that the user established the call manager profile. Extrapolation from Casellini to reach a conclusion that a profile of the user is used is not warranted from the cited material. Accordingly, the rejection of Claims 1 and 29 and all claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Casellini is deemed to be improper.

Second, the Examiner states that the "user has established the call manager profile." In stark contrast, the claimed invention is to the instant messaging service offering options based on a profile of the user. In the application as filed at page 2, lines 8-9, the specification teaches that a subscriber profile is consulted to determine what call handling options to offer the subscriber and how to offer them. This is reflected in the required subject matter of Claims 1 and 29, which includes a limitation to "sending an instant message to the user through the instant messaging service to offer the user one or more options for responding to the call based on a profile of the user". Hence, not only is there a user profile, but the profile is used to determine the instant message sent. Even if Casellini taught a user profile, Casellini did not teach using the profile to determine the message sent. Hence, Casellini does not teach all of the required subject matter of Claims 1 and 29. Accordingly, the rejection of Claims 1 and 29 and all claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Casellini is deemed to be improper.

**Claims 1 and 29**

Applicant amends Claims 1 and 29 in order to further clarify the claimed subject matter. Claims 1 and 29 are amended to include a wherein clause thereby clarifying that the one or more options sent to the user are based upon the profile of the user. Support for the amendment is found in the application as filed at least at page 2, lines 8-9. Casellini does not teach or suggest that options sent to the user are based upon the profile of the user. Accordingly, the rejection of Claims 1 and 29 and all claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Casellini is deemed to be overcome.

**Claim 1**

As to Claim 1, Applicant amends Claim 1 to include subject matter for the case where a speaker is not available at the user's side, establishing verbal-textual communication between the caller and the user by enabling speech-to-text software conversion. Support for this amendment is found at least in Claim 1, at page 5, lines 20-21, which teaches that text-to-speech and/or speech-to-text software may be employed. Further support for the amendments is found in the application as filed at least at page 6, lines 4-5 and at page 9, lines 1-2. The specification also teaches at page 11, lines 3-6 that the subscriber's device may be configured to employ text/speech conversion and at page 11, lines 22-24 that speech-to-text conversion may be applied to provide the message to the subscriber. Further, the specification teaches at page 13, lines 14-15 that text/speech conversion software may be executed as necessary. Casellini does not teach speech-to-text conversion originating from the user. In stark contrast, Casellini's teachings are limited to text-to-speech. Accordingly, the rejection of Claims 1 and all claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Casellini is deemed to be overcome.

**Claims 11 and 30**

As to Claims 11 and 30, the Applicant respectfully disagrees. As described above in reference to Claims 1 and 29, in the cited section Casellini teaches determining where the user is currently accessible via the internet and sending a notification to the user. The Examiner states that the "user has established the call manager profile." As described above for Claims 1 and 11, there are at least two problems with this conclusion.

First, the cited section of Casellini does not state anything about the subscriber having established the call manager profile. There exist a number of methods by which a call manager may be established. For example, the call manager may be a default of program installation having no subscriber configuration. As the call manager may be using default options, it may not be logically induced that Casellini meant for the reader to read into his words that the subscriber established the call manager profile. Extrapolation from Casellini to reach a conclusion that a subscriber profile is used is not warranted from the cited material. Accordingly, the rejection of Claims 11 and 30 and all claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Casellini is deemed to be improper.

Second, the Examiner states that the "user has established the call manager profile." In stark contrast, the claimed invention is to sending a first instant message to the subscriber ... including a set of options ... based on a subscriber profile of the subscriber. In the application as filed at page 2, lines 8-9, the specification teaches that a subscriber profile is consulted to determine what call handling options to offer the subscriber and how to offer them. This is reflected in the required subject matter of Claims 11 and 30. Hence, not only is there a subscriber profile, but the subscriber profile is used to determine the instant message sent. Even if Casellini taught a subscriber profile, Casellini did not teach using the subscriber profile to determine the message sent. Hence, Casellini does not teach all of the required subject matter of Claims 11 and 30.

Accordingly, the rejection of Claims 11 and 30 and all claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Casellini is deemed to be improper.

#### Claim 11

Applicant amends Claim 11 in order to further clarify the claimed subject matter. Claim 11 is amended to include a wherein clause thereby clarifying that the first set of options for handling the call that are sent to the subscriber are based upon the subscriber profile of the subscriber. Support for the amendment is found in the application as filed at least at page 2, lines 8-9. Casellini does not teach or suggest that options sent to the subscriber are based upon the subscriber profile. Accordingly, the rejection of Claim 11 and all claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Casellini is deemed to be overcome.

#### Claim 30

As to Claim 30, the Applicant respectfully disagrees. The subject matter of Claim 30 is required to have a speech-to-text conversion, which is not taught by Casellini. The Examiner cites Casellini at Figure 6 section 500b and Figure 6, section 101a. Neither section fairly teaches speech-to-text conversion. Each section is addressed separately.

Section 500b of Figure 6 is addressed in Casellini at column 5, lines 10-21. The ICM does play a spoken message to the caller. However, this is not a message being sent by the user. Rather, it is a recorded message indicating that the user message is forthcoming. Section 500b, clearly teaches that the subscriber types in the text message, which is received by the ICM application and read to the caller using a standard text-to-speech application. Casellini simply teaches that the subscriber message is typed in, transmitted, and read to the caller. This is text-to-speech as opposed to speech-to-text. As noted by the Examiner in the 35

U.S.C. § 112 first paragraph rejection, speech-to-text conversion is in a separate class from text-to-speech conversion. Section 101a of Figure 6 is described in Casellini at column 4, lines 41-49. First, Casellini distinguishes this section from the above described application. Casellini then describes 101a of Figure 6 as an option for the subscriber to enter a text message that will be read to the caller by the system. This is a classic text-to-speech application. In stark contrast, the claimed subject matter requires a speech-to-text conversion. Hence, speech-to-text is a distinct class from text-to-speech and Casellini does not teach speech-to-text. Therefore, Casellini does not teach all of the subject matter limitations of Claim 30. Accordingly, the rejection of Claim 30 and all claims dependent therefrom under 35 U.S.C. § 102(e) as being anticipated by Casellini is deemed to be improper.

6. Claims 1 and 11 are amended to conform with standard claim drafting practices.

**CONCLUSION**

In view of the above, the Application is deemed to be in allowable condition. The Examiner is therefore earnestly requested to withdraw all outstanding rejections and objections, allowing the Application to pass to issue as a United States Patent. Should the Examiner have any questions regarding the application, he is respectfully urged to contact Applicant's attorney at (650) 474-8400.

Applicant does not believe that filing of this Amendment will incur additional fees. However, the Commissioner is authorized to charge any fees due to the Glenn Patent Group Deposit Account No. 07-1445, Customer No. 22862. Applicant considers this document to be filed in a timely manner.

Respectfully submitted,



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